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OFFICE OF PETITIONS

In re Application of :
Shields, et al. : ON PETITION
Application No.: 09/779,114 :
Filed: February 8, 2001 :
Attorney Docket No.: 74622-040 :
:

This is a decision on the petition under 37 CFR 1.47(a), filed June 13, 2001 (certificate of mailing date June 7, 2001). The petition was only recently forwarded to the Office of Petitions.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on February 8, 2001. On April 9, 2001, the Office mailed a Notice to File Missing Parts of Nonprovisional Application, requiring applicants to submit an executed declaration, a surcharge for its late filing, and substitute drawings. On June 13, 2001 (certificate of mailing date June 7, 2001), petitioners filed, *inter alia*, substitute drawings, a petition under 37 CFR 1.47(a) with required fee, and a \$130 surcharge.

A declaration/statement of facts by Senior I.P. Administrator, Clara L. Navarrette, states that "documents to sign for 09/779,114" were successfully mailed to non-signing inventors, Robert H. Maurer and Michael Cranor, but both men did not return executed documents.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,
- (2) a proper oath or Declaration executed by the available joint inventor(s),
- (3) the petition fee of \$130, and

(4) the last known address of the omitted inventor(s).

This petition lacks items (1) and (2) above.

As to item (1), petitioners have failed to establish that Maurer and Cranor have refused to join in the filing of the above-identified application.

The Office requires that the non-signing inventors be provided with a complete copy of the application as filed. This includes the specification with claims, drawings, if any, and a declaration. See MPEP 409.03(d). The statement of facts does not establish that a complete copy of the application was presented to the non-signing inventors.

Messrs. Maurer and Cranor must have the complete application in their possession in order to make an informed decision as to whether they joins in its filing. When petitioners can show that they were successfully mailed or received the complete application and that they either refused to sign the declaration or would not respond to the request that they sign the declaration within a reasonable amount of time, petitioners will have satisfied this requirement.

With respect to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 still has not been presented. The citizenships of non-signing inventors Maurer and Cranor are not included on the declaration. The citizenship of each inventor must be included **on the oath or declaration**. As listing the citizenship for each inventor is a statutory requirement under 35 U.S.C. 115, it cannot be waived.

In addition, it is noted that petitioners have not submitted Amod Bhargava's added page to the combined declaration.

The signing inventors must execute another declaration contains the signers' and the non-signers' complete information, including citizenship. The inventors should be listed consecutively, so all inventors are aware of the identity of the other inventors.

The undersigned suggests that each available inventor sign in his/her own signature block and leave the non-signers' respective signature blocks blank. Thereby, petitioners will dispense with the necessity of providing an added page to the combined declaration signed by each available inventor.

An oath or declaration in compliance with 37 CFR 1.63 and 1.64 signed by the Rule 1.47 applicants on behalf of the non-signing inventors is REQUIRED. See MPEP 409.03(a).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITION
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Post Office Box 1450
Alexandria, VA 22313-1450

By hand: U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By FAX: (571) 273-8300 - ATTN: Office of Petitions

Telephone inquiries should be directed to the undersigned at (571) 272-3230.



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